

REMARKS

This application was originally filed on 28 December 2001 with thirty-two claims, two of which were written in independent form. Claims 21 and 22 were canceled, and Claims 1, 17, and 18 amended on 27 October 2003, and Claims 1-17 were amended on 21 January 2005. No claims have been allowed.

The specification was objected to for informalities. The specification has been amended as suggested by the Examiner to overcome this objection.

Claims 1-16 were objected to for a variety of informalities. Claims 1, 5, and 6 have been amended to overcome this objection. Specifically, Claim 1 was amended to recite "a total internal reflection prism assembly on *said* illumination path and *a* projection path to separate the illumination and projection paths; and at least one projection lens on *said* projection path for focusing *said* first and second beams on an image plane." Claims 5 and 6 have been amended to clarify the relationship between the total internal reflection prism assembly and the additional limitations of Claims 5 and 6.

Claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,552,840 to Ishii *et al.* ("Ishii") in view of U.S. Patent No. 5,612,753 to Poradish *et al.* ("Poradish"). The applicant respectfully disagrees and submits the Examiner has failed to present a *prima facie* case of obviousness.

The Examiner has the duty to present a *prima facie* obviousness rejection. A *prima facie* obviousness rejection requires more than merely finding each element of the claims in the prior art. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has not pointed to any teaching in the prior art suggesting the combination proposed by the Examiner. Instead, the Examiner merely states, "It would have been obvious to one of ordinary skill in the art at the time of the invention to use the total internal reflection prism of Poradish *et al.* into the image display system of Ishii *et al.* to provide proper illumination

angles while allowing more flexibility in positioning of the element," citing figure 3, and lines 18-19 of column 5 of Poradish.

Referring to Figure 3 of Poradish, the cited passage of Poradish actually states, "As indicated in the figure, for a reflective modulator, a TIR prism 28 is also used in the illumination path to provide the proper illumination angle and to allow the precombined color fields to be imaged by a single projection lens 32."

The applicant respectfully submits this is not a suggestion to modify the display system of Ishii to obtain the recited claim elements. As shown in Figure 1 of Ishii, the display system of Ishii includes reflective modulators 12 and 12' that receive illumination light at the proper angle and allow the combined output from the modulators to be imaged by a single projection lens 5.

The purported suggestion by Poradish does not appear to be applicable to the display system of Ishii, nor is it appear to suggest the modification of Ishii by Poradish as suggested by the Examiner. Thus, the Examiner has failed to show an express or implied suggestion in the art to make such combination or modification, and does not provide any line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by Ex Parte Clapp. Instead, the Examiner merely appears to have used the applicants own claim as a shopping list to combine elements from the prior art. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 2, 3, 5-7, 11, 12, 16, 18, 19, 28, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish. Claims 4 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 6,285,415 to Brennesholtz. Claims 7 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 5,121,983 to Lee. Claims 8-10 and 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent Publication No. 2003/0020809 to Gibbon *et al.* Claims 13 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 6,097,456 to Wang.

Claims 2-16 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. Claims 18-20 and 23-32 depend from Claim 17 and should be deemed allowable for that reason and on their own merits. For the reasons cited above with respect to Claims 1 and 17, the prior art does not show, teach, or suggest the combination of limitations recited by Claims 1 and 17, much less the limitations of Claims 1 and 17 in combination with the additional limitations of the dependent claims.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



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